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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JIANG, SHAOJIA A

ART UNIT PAPER NUMBER

1617

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,817

Applicant(s)

BROWN, RICHARD ALLEN

Examiner

Shaojia A. Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-9, 11-32 and 52-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11-32 and 52-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 2, 2004 has been entered.

This Office Action is a response to Applicant's request for continued examination (RCE) filed February 6, 2004, and amendment and response to the Final Office Action (mailed May 3, 2004), filed September 2, 2004 wherein claims 1-9, 11-32, and 52-58 have been amended; claim 5 is cancelled. Claims 10 and 33-51 are cancelled previously.

Currently, claims 1-4, 6-9, 11-32, and 52-58 are pending in this application.

Claims 1-4, 6-9, 11-32, and 52-58 as amended now are examined on the merits herein.

Applicant's declaration of Richard A. Brown (inventor), submitted September 2, 2004 under 37 CFR 1.132, is acknowledged and will be further discussed below.

Applicant's amendment adding the limitation, i.e., the amount of an emulsifier to claims 1-4, 6-9, 11-32, 53-54, 56, and 58 filed September 2, 2004 with respect to the

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rejection of claims 1-4, 6-9, 11-32, 53-54, 56, and 58 made under 35 U.S.C. 102(b) as being anticipated by Stepnieski et al. (US 5,599,533) for reasons of record stated in the Office Action dated May 3, 2004 have been considered and found persuasive to remove this particular rejection. Therefore, the said rejection is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-9, 11-32, and 52-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenbery et al. (US 5,143,722, of record) in view of Collin et al. (US 5,656,672, PTO-892) and Guthauser (US 5,162,378, of record).

Hollenbery et al. discloses cosmetic or make-up (i.e., a foundation, eyeliner) compositions comprising water-in-oil emulsion comprising the instant ingredients such as an oil phase in amount about 30%, an aqueous phase for example 26% of water by weight which reads about 30%, a pigment herein and a sunscreening agent such as titanium dioxide (TiO₂), an emulsifier broadly having HLB value from 2 to 12 in 0.25-2% by weight, such as the surfactant therein (see col.6 lines 13-45) and a thickener such as quaternium-18 hectorite (see col.6 lines 60-67) in amount for example 0.5% by weight,

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an inorganic salt such as sodium chloride, and a separation inhibitor, a silicone elastomer herein such as organopolysiloxane i.e., cyclomethicone in amount 22.6% for example, proylene glycol, and a preservative such as propyl paraben (see abstract, col.1-2, col.6 lines 11-68, Example 1-6 at col.7-8, and claims 1-15).

Hollenbery et al. does not expressly disclose the employment of the particular emulsifier, cetyl dimethicone copolyol in 3-6% by weight, in the water-in-oil emulsion compositions therein.

Collin et al. discloses a water-in-oil emulsion composition for personal care comprising an oil phase which is present in amount from 10-50% by weight of said composition (see col.2 lines 46-19), an aqueous phase which is present in amount from 50-90% by weight of said composition (see col.2 lines 50-52), an emulsifier such as cetyl dimethicone copolyol (also known as "ABIL EM-90"), 0.5-10% or preferably 1-6% by weight (see col.3 lines 40-47) or 3% in Example 2 and 4 at col.5-6, inorganic salts such as NaCl, 0.6-0.7% in Examples. See also claims 1-23. Collin et al. also discloses the emulsion is stabilized for at least two months at 45°C (see abstract).

Guthauser discloses a water-in-oil emulsion composition for personal care comprising 8-20% of the particular emulsifier, cetyl dimethicone copolyol, having known HLB value from 4 to 6 (see abstract, col.2 lines 30-39, and claim 1 in particular), 20-40% of water, 10-35% of silicone elastomer herein such as cyclomethicone and phenyl dimethicone, 8-20% of inorganic salts, and 1-20 % of PEG (see claims 1-4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the particular emulsifier, cetyl dimethicone copolyol in 3-6% by weight, in the water-in-oil emulsion compositions of Hollenbery et al.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the particular emulsifier, cetyl dimethicone copolyol, in the water-in-oil emulsion compositions of Hollenbery et al, since an emulsifier broadly having HLB value from 2 to 12, is known to be used in the water-in-oil emulsion composition according to Hollenbery. The particular the particular emulsifier, cetyl dimethicone copolyol, is known to have HLB value from 4 to 6 according to Guthauser. More importantly, the similar water-in-oil emulsion composition for personal care of Collin et al. is known to employ an emulsifier such as cetyl dimethicone copolyol in 0.5-10% or preferably 1-6% or **3%** by weight.

Thus, an emulsifier, cetyl dimethicone copolyol in 0.5-10% or preferably 1-6% or **3%** by weight is known and art-recognized which can provide the HLB value as the water-in-oil emulsion composition of Hollenbery et al. desired to give water-in-oil emulsion. Therefore, one of ordinary skill in the art would have reasonably expected that a known and art-recognized emulsifier, cetyl dimethicone copolyol, having HLB value from 4 to 6, in 0.5-10% or preferably 1-6% or **3%** by weight would have the same or substantially similar usefulness as other emulsifiers therein in water-in-oil emulsion compositions of Hollenbery et al, based on the disclosure of Collin et al. and Guthauser.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-9, 11-32, and 52-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stepnieski et al. (US 5,599,533, of record) in view of Rapaport (US 5730991, of record) and Dorogi et al. (US 5882661, of record).

Stepnieski et al. discloses cosmetic compositions comprising water-in-oil emulsion comprising the instant ingredients such as an oil phase in the instant amount (see col.2 line 56 to col.3 line 18), an aqueous phase in the instant amount (see col.4 lines 55-58), a pigment herein, vitamin A and E, a suncreening agent broadly and pigments broadly such as titanium dioxide (TiO₂) and a preservative (see col. 4 line 4 to col.5 .line 7), an emulsifier or surfactants having HLB of 2-6 broadly in 0.01-20% or 0.1-4 % by weight (see col.2 lines 29-35), or the particular emulsifier or surfactant, cetyl dimethicone copolyol in 0.5% by weight (see col.4 27-28 and col.5 Example 1) and a thickener such as such as quaternium-18 hectorite in the instant amount (col.3 lines 45-65 and col.4 line 4), and a separation inhibitor, a silicone elastomer herein such as organopolysiloxane in the instant amount, i.e., cyclomethicone (see col.2 lines 19-45),

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prooylene glycol and an inorganic salt such as sodium chloride (see col.3 lines 51-61).

See also abstract, Example 1-6 at col.5-6, and claims 1-40.

Stepnieski et al. does not expressly disclose the employment of the particular emulsifier, cetyl dimethicone copolyol in 3-6% by weight, the particular suncreening agent herein and the particular preservative herein in the water-in-oil emulsion compositions therein.

Rapaport discloses that octyl methoxycinnamate is well known sun screening agent. See col.17 lines 20-25, col.19 line 10.

Dorogi et al. discloses that phenoxyethanol, propyl paraben and methyl paraben are preferred preservatives therein used in personal care or conditioning human skin, hair or nails compositions (see col.5 lines 17-18).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the particular emulsifier, cetyl dimethicone copolyol in 3-6% by weight, in the water-in-oil emulsion compositions of Stepnieski et al., and to employ octyl methoxycinnamate as sun screening agent, and to employ phenoxyethanol, propyl paraben and methyl paraben as a preservative.

One having ordinary skill in the art at the time the invention was made would have been motivated to determine or optimize cetyl dimethicone copolyol to 3-6% by weight, since an emulsifier or surfactants having HLB of 2-6 broadly in 0.01-20% or 0.1-4 % by weight is known according to Stepnieski et al. Hence, the claimed range 3-6% lies inside ranges disclosed by the prior art. Thus, a *prima facie* case of obviousness

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exists. See *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See also MPEP 2144.05.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ octyl methoxycinnamate as sun screening agent, and to employ phenoxyethanol, propyl paraben and methyl paraben as a preservative, since sun screening agent and a preservative broadly, are known to be used in the water-in-oil emulsion composition according to Stepnieski et al. The particular sun screening agent, octyl methoxycinnamate, and phenoxyethanol, propyl paraben and methyl paraben as preservatives are well-known in the art to be used in personal care or conditioning human skin, hair or nails compositions. Therefore, one of ordinary skill in the art would have reasonably expected that a known and art-recognized sun screening agent, octyl methoxycinnamate, and preservatives such as phenoxyethanol, propyl paraben and methyl paraben, would have the same or substantially similar usefulness as other sun screening agents and preservatives in water-in-oil emulsion compositions of Stepnieski et al.

Moreover, it has been well settled that recitation of an inherent property of a composition, e.g., the inherent stability of composition, will not further limit claims drawn to a composition.

Response to Argument

Applicant's arguments filed September 2, 2004, with respect to the prior art rejections of record in the previous Office Action have been considered but are moot in view of the new ground(s) of rejection above.

Applicant's declaration under 37 CFR 1.132, submitted September 2, 2004, has been considered but is not persuasive to overcome the rejections made under 35 U.S.C. 103(a) for the following reasons. Note that Example 1-2 in the specification (page 16-20) shows the particular formulation with specific ingredients and amounts. The scope of the showing must be commensurate with the scope of the claims. *In re Coleman*, 205 USPQ 1172; *In re Greenfield*, 197 USPQ 227; *In re Lindener*, 173 USPQ 356; *In re Payne*, 203 USPQ 245. Thus, the evidence in the example herein is also not commensurate in scope with the claimed invention and does not demonstrate criticality of a claimed range of the ingredients in the claimed composition. Moreover, Example 1-2 in the specification employs cetyl dimethicone copolyol in 4% by weight.

Note that Applicant discussed the testing results of the stability by "Comparative Sample A and B" in the declaration, at 50°C. Nonetheless, the instant claims are not limited to the stability at the particular temperature.

Therefore, the declaration is ineffective to rebut the prima facie case herein.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The

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fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Anna Jiang, Ph.D.
Primary Examiner, AU 1617
November 23, 2004